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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,240	05/24/2001	Troy M. Herndon	8032943	3955

7590 05/01/2003

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EXAMINER

NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/865,240	HERNDON ET AL.	
	Examiner	Art Unit	
	Tran N. Nguyen	2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The corrected or substitute drawings were received on 1/6/03. The Examiner of the record approves these drawings.

Response to Arguments

The applicant allegedly states that "the e-coating itself is of course well known; it appears in the prior art cited by the Examiner," (Applicant's remark, line 6+) the applicant further adds that "it is clearly an insulating coating as is well known in the art and is described in the reference cited by the Examiner" (Applicant's remark, line 12+). Then, the applicant simply concludes "Therefore, the coating was described with sufficient detail to inform a person of skill in the art in the application as filed."

Furthermore, the applicant responds to the Examiner's inquiry about the material that is used in the so-called e-coating by stating that the material used in the "e-coating" is not relevant, but rather it is well known in the field.

In response to this argument, first of all, the applicant seems repeatedly argue that the so-called "*e-coating*" is well known based on the disclosure of the prior art references cited by the Examiner. What the applicant appears to imply is the insulation coating is well known, and described in the prior art cited by the Examiner, not the so-called "*e-coating*". The term "e-coating" is not a well-known term for electrical-insulating-material coating, as allegedly stated by the applicant.

Instead of proving that the application's own disclosure does describe what is "e-coating" and its function, the applicant keeps on referring to the prior-art references, which are cited by the Examiner, for the disclosure and description of the insulation coating (which is also known in the art as electrical-insulation or electrical-insulating coating/layer or even known as electrical-isolating or electrical-resistant or electrical nonconductive coating/layer or more specific such as epoxy-resin or plastic coating/layer, wherein resin and plastic is well known as electrically insulating materials). The applicant correctly states that insulation coating was describe and well known in the art. However, the "*e-coating*" is not, or at least the term "e-coating" is not a well-known term for referring to insulating-material coating in the art.

Rather than using the present application's own disclosure to address what is the "e-coating", it seems to the Examiner that the applicant strives to explain or strive to compensate for the short-coming description of the *e-coating* in the present application's own disclosure by using the cited prior art references' insulation-coating disclosures as an explanation for the term "e-coating".

The application's disclosure (page 6) merely describes the so-called e-coating as follow:
[0021] "[a]n e-coating which is provided over the stator laminations. Eliminating this coating ensures grounding of the lamination stack against the conductive surface of the shaft", and
[0022] "[s]harp features 304 will cause the e-coating to be scraped off the end and sides of the lamination features 304. Thus stator ground is achieved with no additional parts".

By merely stating that *eliminating this coating ensures grounding of the lamination stack against the conductive surface of the shaft* the disclosure *does not* provide sufficient description of the e-coating. The term "ensure" is not necessary means to initially establish or make the

electrical grounding, as seemed alleged in the applicant's argument, but rather the term "*ensure*" simply means to make sure about the grounding, i.e., the grounding is assumed to possibly already established, the scraping of the "e-coating" simply makes sure (or ensures) the grounding is therebetween the shaft and the laminations.

Again, because the disclosure fails to either describe the material or the function of the "e-coating", one skilled in the art might raise an argumentative assumption that with the "e-coating", which is made of any suitable materials (but not necessary an insulation, as allege by applicant), the grounding of the lamination stack against the conductive surface of the shaft might be somewhat establishes—it might not surely establishes the grounding, but still somewhat establish such electrical grounding. Therefore, to make sure or to ensure about the grounding therebetween, the projection features (304) of the laminations must directly contact the surface of the shaft by scraping the e-coating of the laminations. This argumentative assumption might not clearly explain what is the material or function of the "e-coating" but it would places the argument that the "e-coating" is an insulation coating in questionable doubt. Again, the disclosure fails to either describe the material or the function of the e-coating, any argumentative interpretation of the term "e-coating" is possible, and is not limited only to electrical insulation coating, as allegedly argued.

If the specification were written to define what is the so-called "e-coating" by disclosing what is the material of the so-called "e-coating", e.g., broadly nonconductive material, or what is the function of the e-coating, e.g., for broadly insulating electrical conducting, then those skilled in the art would understand that the e-coating is an electrical-insulation coating/layer, as allegedly argued by the applicant. However, the disclosure not only fails to define the term "e-

coating" in the specification, but also fails to describe what is the material or what is function of the "e-coating". When the Examiner inquires the material in the "e-coating" in order to gain understanding what is the so-called "e-coating" and its function, the applicant simply replies that such information is not relevant. To the Examiner, it is relevant because it would clearly provide the understanding about e-coating's function.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The following is the Previous Office Action is hereby included.

Specification

The disclosure is objected to because of the following: it is unclear what is the so-called "*e-coating*" (page 6 line 2).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1-4 and 6-8** are rejected under 35 U.S.C. 112, ***first paragraph***, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not clear disclose what is the material of the so-called "e-coating"?
2. **Claims 1-8** are rejected under 35 U.S.C. 112, ***second paragraph***, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "an e-coating" is indefinite because it is not clear what is the material of the so-called "e-coating"?

In claim 5, "the stack laminations and "the stator stack" lack antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 5** is rejected under 35 U.S.C. 102(b) as being fully anticipated by Aiello et al (US 5965966).

Aiello discloses a spindle motor comprising a shaft (122) in a hub (100) with a permanent magnet rotor radially aligned with a stator (129) supported by outer surface of the shaft, an electrical grounding means (200) incorporated with an inner yoke of the stack laminations to conductively and rigidly fixing the stator stack relative to the magnet while grounding the stator.

Regarding claims 1-4, and 6-8, given 35 USC 112 deficiencies set forth above and uncertainty as to the proper interpretation of the limitations of claims, it would not be proper to reject claims 1-8 on the basis of prior art. Therefore, no prior-art rejection against claims 1-4, 6-8 is given at this time.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N Nguyen whose telephone number is (703) 308-1639. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703)-308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3431 for regular communications and (703)-395-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1782.


TRAN NGUYEN
PRIMARY EXAMINER